

## **REMARKS**

Reconsideration of the application, as amended, is respectfully requested. Also, enclosed with this amendment is a petition to revive the present application pursuant to 37 C.F.R. 1.137(b) for unintentional abandonment, a check in the amount for \$750 covering the required petition fee under 37 C.F.R. 1.17(m), and accompanying supporting documents. It is noted that the Applicant is a small entity. No additional fees are believed due with this amendment. However, if any additional fees are due, the Commissioner of Patents is authorized to charge my deposit no. 11-1152.

### **I. STATUS OF CLAIMS**

Claims 1, 5-10, 12, 13, 17-19, 21, 24-27, 29-31, 33-37, 40, 41 and 43-49 are pending in this application. Claims 4, 16, 20, 28, 38, 42 have been canceled without prejudice. Claims 1, 12, 13, 21, 33, 43, 44 and 46-49 have been amended to more particularly point out and distinctly claim that which applicants regard as their invention. It is respectfully submitted that no new matter has been added by virtue of this amendment. Support for the amended claims is found throughout the specification as originally filed. In particular, support for amended claims 1, 12, 13, 21, 33, 43, 44 and 46-49 may be found on page 15, lines 4-22, page 20, lines 17-19, page 21, lines 1-18, Figs. 14-16 and pages 1-2 of Appendix B of the present specification.

### **II. Claim Objections**

The Examiner objected to claims 20 and 42 on the grounds that it was unclear whether these claims had been canceled or not in the previous amendment.

In response, Applicants note that they intended to have these claims canceled in the previous amendment but inadvertently left them within the body of the claim set.

In any event, claims 20 and 42 have now been properly canceled herewith without prejudice.

In view of the above action taken, removal of the objection is respectfully requested.

**III. 35 U.S.C. 112, first paragraph**

Claims 20 and 42 were rejected under 35 U.S.C. 112, first paragraph as failing to enable one skilled in the art to make or use the invention recited in these claims.

Claims 20 and 42 have been canceled herewith without prejudice. The cancellation of these claims was made for the sole purpose of expediting prosecution of the present application and should not be deemed as an admission regarding the merits of the Examiner's rejection.

Accordingly, the Examiner's rejection of these claims is now moot.

**IV. 35 U.S.C. § 112, second paragraph**

Claims 12, 13, 21 and 43 were rejected as being indefinite due to the phrase "and/or" recited in these claims.

In response, claims 12, 13, 21 and 43 have been amended to replace “and/or” with the expression “and”.

Claim 49 was rejected as improperly depending from claim 47.

In response, claim 49 has been amended to depend from claim 48 in accordance with the Examiner’s suggestion.

In view of the above actions taken, removal of the above rejections is respectfully requested.

**V. REJECTIONS UNDER 35 U.S.C. § 103(a)**

**A. Rejection of Claims 1, 5-11, 13, 17-20, 33, 40-43 under 35 U.S.C. 103 (a) over U.S. Patent No. 6,071,166 to Lebensfeld et al. in view of U.S. Patent No. 6,254,486 B1 to Mathieu et al**

Claims 1, 5-11, 13, 17-20, 33, 40-43 were rejected under 35 U.S.C. 103 (a) over U.S. Patent No. 6,071,166 to Lebensfeld et al. (“the Lebensfeld patent”) in view of U.S. Patent No. 6,254,486 B1 to Mathieu et al (“the Mathieu patent”).

In response, it is respectfully submitted that there is no motivation provided to one skilled in the art to combine the Lebensfeld and Mathieu patents. Further, even if there were motivation

to combine these references, this combination would still fail to teach or suggest all of the elements of claims 1, 13, 33 and 43, as amended.

The fact that a device of a reference can be modified according to one or more additional references, alone is insufficient for establishing a motivation to combine. *M.P.E.P. § 2143.01*. Rather, there must be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See again M.P.E.P. § 2143.01*. However, the Lebensfeld patent is completely silent regarding providing it toy devices with a motor or motorized means. Moreover, the toys described in Lebensfeld are clearly of the type not designed to be motorized, but rather wherein the principle purpose and enjoyment of these types of toys is to allow the user to manually control all movements by hand. The fact that both patents discuss battle situations, without more, is insufficient motivation for one skilled in the art to modify the principle of operation of a particular type of toy device with an additional unnecessary feature.

Even assuming *arguendo* that there were motivation to make the above proposed combined, this combination would still fail to teach each and every element of the presently claimed invention as recited in independent claims 1, 13, 33 and 43.

In this regard it is noted that claims 1, 13, and 33 have been amended herewith to further clarify that the data storage device is a swipe card and that the data reader-writer of the amusement device is also adapted such that one or more additional swipes of the swipe card while the device is in operation results in the enhanced function being further enhanced. In addition, claim 43 has been amended herewith to further clarify that the data card reader of the amusement device is also adapted such that one or more additional swipes of the data card while the device is in operation results in the enhanced function being further enhanced. It is further

noted that this amendment has been made in order to expedite the prosecution of the present application and should not be deemed as being an admission in view of the prior art.

At the very least the above proposed combination fails to teach or suggest a swipe card separate from said amusement device as recited in independent claims 1, 13 and 33, as amended or a data card separate from said amusement device, as recited in independent claim 43, as amended.

For the reasons set forth herein above, withdrawal of the rejection of claims 1, 13, 33 and 43 is respectfully requested. As claims 5-10 depend from and incorporate the limitations of independent claim 1 and claims 17-19 depend from and incorporate the limitations of independent claim 13, withdrawal of the rejection to these claims is also requested.

**B. Rejection of Claims 4, 12, 16, 34-38, 44-47 and 49 under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5,768,223 to Li et al.**

Claims 4, 12, 16, 34-38, 44-47 and 49 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5,768,223 to Li et al ("the Li patent").

In response, it is respectfully asserted that the combination of Lebensfeld, Mathieu and Li fails to teach or suggest the all of the features recited in claims 1, 12, 13, 33, and 43 as amended.

First, for the reason stated above, there is no motivation provided to one skilled in the art to combine the Mathieu patent with the Lebensfeld patent. Accordingly, the Examiners proposed combination of Lebensfeld, Mathieu and Li also fails.

However, even assuming arguendo that there were motivation to make the above combination, this combination would still fail to teach or suggest each and every element recited in claims 1, 12, 13 and 33, as amended. The Li patent fails to cure the deficiencies of the Lebensfeld and Mathieu patents for the reasons discussed below.

As mentioned, claims 1, 13 and 33 have been amended herewith to further clarify that the data storage device is a swipe card and that the data reader-writer of the amusement device is also adapted such that one or more additional swipes of the swipe card while the device is in operation results in the enhanced function being further enhanced. . In addition, claim 43 has been amended herewith to further clarify that the data card reader of the amusement device is also adapted such that one or more additional swipes of the data card while the device is in operation results in the enhanced function being further enhanced. Moreover, claim 12 has been amended to further clarify that the means for communicating information to the amusement device comprises a swipe card, discrete from the device, and a data reader-writer, and wherein the data reader-writer of the amusement device is also adapted such that one or more additional swipes of the swipe card while the device is in operation results in the enhanced function being further enhanced.

Specifically, the Li patent at the very least fails to teach or suggest a data card reader-writer adapted such that additional or multiple swipes of a swipe card (claims 1, 12, 13 and 33) or data card (claim 43) through a data card-reader-writer during operation of its apparatus further enhances a function already enhanced, as required by the presently claim invention of amended claims 1, 12, 13, 33 and 43 as amended. Although, the Li patent mentions on Col. 7, lines 50-64, that a control card can be inserted into a card slot 210 of the toy robot for activating an LED set 64, speaker unit 232 to generate audible sound output and motor unit to generate predetermined movement, the Li patent still fails to teach the above noted features recited in claims 1, 12, 13 and 33. Rather, the Li patent only teaches activating a specific function through use of its control card through the card slot. However, the Li patent makes no mention of its card slot 210 being adapted

to receive additional or multiple swipes of a control card through its card slot during operation of its apparatus to further enhance a function that has already been activated, as required by claims 1, 12, 13, 33 and 43 as amended. Accordingly, even if one were to incorporate the control card/card slot features of Li, with the device of Lebensfeld as modified by Mathieu, they would at best arrive at a toy device, wherein one or more functions could be activated via an initial swipe of its control card but wherein one or more additional swipes of its control card during the operation of its device would not result in the further enhancement of any of these activated functions, as is required by the presently claimed invention.

A good illustrative example of how the data card reader of the presently claimed invention recited in claim 35 further enhances a function already enhanced through one or more additional swipes of the data card during operation of the apparatus is described on page 20, lines 17-19 and page 21, lines 1-18 and Figs. 14-16 of the present specification. This particular embodiment of the presently claimed invention sets forth an example of how the defense function of the amusement device is further enhanced during operation of the device by one or more additional swipes of a swipe or data card.

The above embodiment describes, for example, how one swipe can enhance the defense of the device by partially closing the iris 86 to better prevent an opponents IR beam from penetrating into an IR receiver behind the iris 86. The present specification goes on to describe how in this embodiment the defense function of the device is then further enhanced by closing the partially closed iris 86 even further in response to additional swipes of the data card through the data card reader, until if desired the iris 86 is placed into a fully closed position. In particular, this embodiment mentions how approximately up to 5 additional swipes of the data card after the initial swipe ( a total of six swipes) will move the iris 86 to a fully closed position, thereby fully preventing an opponents IR beam from penetrating into an IR receiver behind the iris 86 .

Additional examples regarding how the swipe card and data card reader-writer of the presently claimed invention work together to further enhance a function of an amusement device already enhanced through one or more additional swipes of the swipe card may be found throughout the specification as originally filed and in particular on pages 1-2 of Appendix B of the present specification.

The Li, Lebensfeld and Mathieu patents each clearly fail to teach or suggest the swipe data card reader-writer features of amended claims 1, 12, 13, 33 and 43 mentioned above.

Therefore, for the reasons set forth herein above, withdrawal of the rejection of claim 12 is respectfully requested. As claim 16 depend from and incorporate the limitations of independent claim 13, claims 34-38 depend from and incorporate the limitations of independent claim 33 and claims 44-47 and 49 depend from and incorporate the limitations of independent claim 43 , withdrawal of the above noted rejections to these dependent claims is also respectfully requested.

**C. Rejection of Claims 21, 23, 26, 30-32 under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5, 100,138 to Wilde, U.S. Patent No. 3,659,379 to Suda, U.S. Patent No. 3,199,249 to Carver et al.**

Claims 21, 23, 26 and 30-32 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld et al patent and the Mathieu patent in view of U.S. Patent No. 5, 100,138 to Wilde ("the Wilde



patent”), U.S. Patent No. 3,659,379 to Suda (“the Suda patent”), U.S. Patent No. 3,199,249 to Carver et al (“the Carver patent”).

Claim 21 has been amended herewith to further clarify that the data storage device is a swipe card and that the data reader-writer of the amusement device is also adapted such that one or more additional swipes of the swipe card while the device is in operation results in the enhanced function being further enhanced.

In response, the above proposed combination fails to teach or suggest all of the features recited in claim 21, as amended. As mentioned above, the Lebensfeld and the Mathieu patents each fail to teach or suggest the swipe card which is separate from said amusement device as recited in claim 21. Moreover, the Wilde, Suda and Carver patents each fail to cure the deficiencies of the Mathieu patent and the Lebensfeld patent because these patents likewise fail to teach or suggest a swipe card which is separate from said amusement device as recited in claim 21.

Withdrawal of the rejection of independent claim 21 is respectfully requested. As claims 26, 30 and 31 depend from and incorporate the limitations of independent claim 21, withdrawal of the rejection of these claims are also requested.

**D. Rejection of Claims 24-25, 27-29 and 48 under 35 U.S.C. 103 (a) over the Lebensfeld patent, Mathieu patent, the Wilde patent, the Suda patent, and the Carver patent in view of Li et al.**

Claims 24-25, 27-29 and 48 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld patent, the Mathieu patent, the Wilde patent, the Suda patent, the Carver patent in view of U.S. Patent the Li patent.

As mentioned above with regard to claims 1 and 33, the combination of Li, Lebensfeld and Mathieu fails to teach or suggest a data card reader-writer adapted such that additional or multiple swipes of a swipe card (claim 21) or data card (claim 43) through a data card-reader-writer during operation of its apparatus further enhances a function already enhanced. Since claims 21 and 43, as amended, also recite the above noted features, the above combination likewise fails to teach or suggest all of the features recited in claims 21 and 43. As claims 24-25 and 27-29 depend from and incorporate all of the limitations of claim 21 and claim 48 depends from and incorporates all of the limitations of claim 43, withdrawal of the rejection to these dependent claims is also respectfully requested.

**V. CONCLUSION**

In view of the actions taken and arguments made it is believed that all pending claims as

currently presented are now in condition for allowance. A Notice of Allowance is respectfully requested.

According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned at the telephone number provided below in the event that a telephone interview will advance the prosecution of this application. An early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Richard B. Klar', is written over a horizontal line.

Richard B. Klar

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